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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,980	01/16/2004	Gregory Paul Olmstead		8335

7590 07/26/2004
Mobile Thinking, LLC
#115
4019 Goldfinch Street
San Diego, CA 92103

EXAMINER

FERNSTROM, KURT

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,980

Applicant(s)

OLMSTEAD, GREGORY PAUL

Examiner

Kurt Fernstrom

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As discussed below, it is not clear whether applicant is attempting to claim an apparatus or a method. However, the closest guess is that "one or more computer programs" are being claimed. Computer programs in and of themselves are not patentable subject matter, because they are not fixed in a tangible medium, and thus are not properly considered to be machines, manufactures or compositions of matter. Rather, the invention amounts to the mere manipulation of abstract ideas.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims contain numerous examples of language which renders the claims indefinite. Claim 1 recites a "method and means for recording, storing and displaying discrete trial data". This makes it unclear whether the invention is directed to a method or an apparatus.

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Also, the term "other metrics" in claim 1 is overly broad, and does not sufficiently define the scope of the claimed subject matter. Claims 2-4, 6 and 7 recite "[t]he computer programs of claim 1." However, claim 1 does not recite as the invention computer programs; it recites a method and means as described above. Claim 2 recites the phrase "by dint of the processes in claim 8 or claim 9", which is indefinite because "by dint of" is an overly broad phrase and also because there is no claim 8 or claim 9. Claim 3 recites that a method may be used to ensure the uniqueness...". Firstly, the use of the word "may" renders the language indefinite, as it is not clear whether the method is being positively recited as part of the invention. Secondly, no particular method steps are recited which would achieve the claimed results. Methods must be claimed using specific, concrete steps, to enable one of ordinary skill in the art to understand and perform the method. Claims 6 and 7 recite the limitation "the user interface to display performance data and other metrics" in line 1. There is insufficient antecedent basis for this limitation in the claim. Also, claim 6 refers to times and dates of different devices described in claim 2. This is improper, as claim 6 depends from claim 1, not claim 2. Also, neither claim 1 nor claim 2 describes operating system times and dates. Also, it is not clear what is meant by "different devices"; because "devices" is a broad term and because neither claim 1 nor claim 2 recites any devices.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook. Cook discloses a device and method of providing instruction to students on a computer comprising various databases of information, including accounts for each student and an interface for tracking a student's progress, where content can be added or modified. While certain claimed steps are not explicitly disclosed, including the display of "discrete trial data and other metrics" and various other specific bits of information recited in the claims, it is well known in database applications to allow for the inclusion and modification of many different types of information as desired. The claim limitations of claims 1-7 are obvious variations on the disclosure of Cook and well known principles of database management.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stuppy, Safran, O'Connor, Owens, Vaughan, Abrahamson, Siefert and Parry disclose various computer teaching methods and devices involving the use of databases to store and display information.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF
July 23, 2004

Kurt Fernstrom
Kurt Fernstrom

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